

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION

CLONTECH LABORATORIES, INC.,

Plaintiff,

v.

BAYLOR COLLEGE OF MEDICINE and
BCM TECHNOLOGIES, INC.,

Defendants.

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Civil Action No. H02-0017

**COVENANT NOT TO ASSERT U.S. PATENT NO. 5,851,808
AGAINST CLONTECH LABORATORIES, INC.**

Whereas, defendant Baylor College of Medicine is the assignee of U.S. Patent No. 5,851,808 (the "'808 Patent").

Whereas, Invitrogen Corporation ("Invitrogen") is the exclusive licensee of the '808 patent.

Whereas, this declaratory judgment action relating to the '808 Patent, filed on January 4, 2002, by plaintiff, Clontech Laboratories, Inc. ("Clontech"), against the defendants, Baylor College of Medicine and BCM Technologies, Inc. (collectively "Baylor") sought a declaratory judgment that Clontech did not infringe the '808 Patent and/or that the '808 Patent was invalid (Docket No. 1).

Whereas, Baylor moved to dismiss the complaint under Fed. R. Civ. P. 12(b)(1) for lack of subject matter jurisdiction on the ground that there was no case or controversy between the parties (Docket No. 12).

EXHIBIT A

Whereas, on February 6, 2003, this Court denied that motion, finding, *inter alia*, that Baylor has not assured either this Court or Clontech that it will not bring an infringement suit against Clontech (Docket No. 31).

Now, therefore, Baylor and Invitrogen hereby covenant not to assert the '808 Patent against Clontech with respect to its past Creator™ products, and existing Creator™ products as of the date of this covenant. This covenant is without prejudice to Baylor and Invitrogen's right to assert the '808 Patent against other parties. This covenant also is without prejudice to any other patents, including continuations, continuations-in-part, divisionals, reissue, and reexamined patents, as well as foreign counterparts.

Dated this 20th day of March, 2003.

AGREED:



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Non-Party Invitrogen Corporation

#3672156

Notice: The attached order has been entered.



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4:02-cv-00017 #35
5 page(s).
04/07/03

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